

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

General Electric Company
v.
Asha Records, Inc.

Opposition No. 101,856
to application Serial No. 74/643,224
filed on March 7, 1995

David Goldberg, Mary L. Kevlin and Robin J. Adelson of
Cowan, Liebowitz & Latman for General Electric Company.

Andrea I. Brauer for Asha Records, Inc.

Before Simms, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

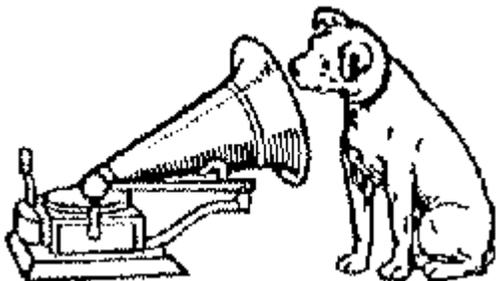
An application has been filed by Asha Records, Inc. to
register the mark shown below



ASHA RECORDS

for "pre-recorded tapes, phonograph records and compact discs featuring music."¹

Registration has been opposed by General Electric Company under Section 2(d) of the Trademark Act on the ground of likelihood of confusion. Opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered mark shown below



for musical sound recordings and video sound recordings, as well as various electronic products and licensed merchandise, as to be likely to cause confusion, or to cause

¹ Application Serial No. 74/643,224, filed March 7, 1995, based on a bona fide intention to use the mark in commerce. Applicant subsequently filed an amendment to allege use setting forth a date of first use anywhere of March 1, 1995 and a date of first

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mistake, or to deceive. Opposer owns registrations of the mark for radios, microphones, and loud speakers;² stereo

use in commerce of May 15, 1995. The word "Records" is disclaimed apart from the mark.

² Registration No. 195,475, issued February 25, 1925; thrice renewed.

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speakers;³ television sets;⁴ and musical sound recordings and musical video sound recordings.⁵

Applicant, in its answer, denied the salient allegations of likelihood of confusion.

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party;⁶ certified copies of opposer's pleaded registrations, applicant's responses to certain interrogatories, excerpts from printed publications, and advertising materials and catalogs,⁷ all introduced by way of opposer's notices of reliance; opposer's response to one interrogatory, official records (two of opposer's registrations which were not pleaded), and excerpts from materials identified as "printed publications,"⁸ made of

³ Registration No. 1,184,589, issued January 5, 1982; Section 8 filed.

⁴ Registration No. 1,184,590, issued January 5, 1982; combined Sections 8 and 15 affidavit filed.

⁵ Registration No. 1,938,683, issued November 28, 1995.

⁶ Pursuant to a stipulation, opposer's rebuttal testimony was submitted in the form of a declaration.

⁷ Promotional materials and catalogs are not proper subject matters for a notice of reliance. TBMP §708 (see cases cited thereat). However, applicant did not object to this introduction, but rather treated the evidence as being properly of record. Accordingly, we have considered this evidence in reaching our decision.

⁸ The excerpts appear to be pages from a catalog showing merchandise licensed by opposer. As in the situation mentioned above, such material is not proper for introduction into evidence by way of a notice of reliance. Nonetheless, no objection

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record in applicant's notice of reliance. Both parties filed briefs on the case. An oral hearing was not requested.

Opposer's mark has been used for nearly 100 years in connection with the sale of pre-recorded music and related electronic products. The mark is based on Francis Barraud's painting entitled "His Master's Voice" which depicts the painter's fox terrier (named "Nipper") looking into a phonograph player, with his head tilted quizzically to one side as if listening. Over the years the mark has appeared on records, CDs and tapes featuring recording artists such as Elvis Presley, Jimi Hendrix, Perry Como, Bruce Hornsby and ZZ Top. Over the past ten years, more than 175 million records, tapes and CDs bearing the mark have been sold in the United States. This represents over \$1.1 billion in sales. During this same time period, advertising and promotional expenditures have exceeded \$185 million. The mark also has appeared on a wide variety of collateral merchandise, and the mark has been the subject of many articles appearing in printed publications.

Applicant took the testimony of David Horne, its president. Mr. Horne explained the selection of applicant's mark as follows:

thereto was raised, but rather the material was treated as if properly of record. Thus, we have considered this evidence.

I chose Asha Records because that is my daughter's name, my eight-year-old daughter at the time, and since I named my daughter and she seemed to be a fresh enough symbol, I figured with her name, I'd have a--I'd have good luck. The bunny rabbit came strictly because my daughter had just lost her only bunny rabbit. We just buried the bunny rabbit in the yard, and she asked me to use it as a logo or label or something--do something to commemorate the rabbit. And when I went looking for some symbol to fit, I saw the grammophone [sic] that looked like a flower, and the rabbit and the Asha Records all three together, it looked like a winner to me. (dep., p. 8)

Mr. Horne went on to characterize applicant's mark in the following way:

As a rabbit watching a flower, which includes music, under which I have my daughter's name. So what I have is what my daughter wanted, and I also have a relationship to something natural in the music business, and to me, that's what worked. (dep., p. 25)

The record shows that applicant's mark has been applied to records, cassette tapes and CDs. Applicant has listed sales under the mark in 1995 as \$5,500 and zero dollars in 1996. Advertising expenditures in 1995 were \$30,000 (for promotional CDs, videos, T-shirts and travel to conferences) and \$5,000 in 1996.

In view of opposer's ownership of valid and subsisting registrations for its pleaded mark, there is no issue with respect to opposer's priority. King Candy Co., Inc. v.

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Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In any event, the record clearly establishes that opposer began using its mark long prior to applicant's first use.

Our determination under Section 2(d) is based on an analysis of all of the probative factors in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding are discussed below.

With respect to the goods, opposer's musical sound recordings are, for purposes of our likelihood of confusion analysis, legally identical to applicant's tapes, records and CDs featuring music. Moreover, applicant's goods are related to opposer's electronic products. The parties' goods are sold in the same channels of trade to the same classes of purchasers. In addition, as pointed out by opposer, musical sound recordings on records, CDs and tapes are relatively inexpensive items and are purchased with nothing more than ordinary care.

We next turn to consider the marks. Given the identity, at least in significant part, between the parties' goods, we note, at the outset, that when marks are applied to identical goods, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion

declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In the present case, we find that the marks convey sufficiently similar overall commercial impressions, as applied to identical and substantially related goods, that consumers are likely to ascribe a common source to the goods. Both marks comprise a left-sided profile view of a seated animal on the right peering into an old fashioned phonograph player on the left. The presence of the words ASHA RECORDS in applicant's mark does not serve to adequately distinguish the two marks, especially as applied to identical goods. As often stated, the addition of a trade name to one of two otherwise similar marks will not serve to avoid a likelihood of confusion. First International Services Corp. v. Chuckles Inc., 5 USPQ2d 1628, 1632 (TTAB 1988). As posited by opposer, the addition of the words ASHA RECORDS may lead consumers to believe mistakenly that applicant's products are part of a division of opposer or a line extension offered by opposer or one of its divisions.

It hardly need be said that the fame of opposer's mark is a critical du Pont factor in opposer's favor in this case. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992)["[F]ame of the prior mark plays a dominant role in cases featuring a famous

or strong mark."] As indicated in its brief (p. 8), "[a]pplicant readily admits to the fame of Opposer's mark." Indeed, the record clearly establishes the widespread fame of opposer's mark. Opposer's claim that its mark is famous is supported by truly impressive sales and significant advertising figures, and by stories about opposer's mark. The authors of some of the stories essentially characterize opposer's mark as one of the most enduring commercial trademarks ever. Further, the record is devoid of any third-party uses or registrations⁹ of similar marks for goods of the type involved here.

Another factor that bears upon our determination is the circumstances surrounding applicant's adoption of its mark. A party which knowingly adopts a mark similar to one used by another for the same goods does so at its peril. In such cases, all doubt on the issue of likelihood of confusion must be resolved against the newcomer. *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989); *Kimberly Clark Corp. v. H. Douglas Enterprises, Ltd.*, 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985); and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). Here, Mr. Horne was aware, prior to his

⁹ The trademark search report is insufficient to make of record the third-party registrations cited therein. *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883 (TTAB 1983). We hasten to add that even if the third-party registrations were of

selection of the involved mark, of the use of opposer's mark for goods identical to those of applicant. In fact, Mr. Horne testified that he "grew up" with the "dog and phonograph mark" and that "the mark was kind of everywhere." (dep., p. 18) Thus, out of an entire universe of trademarks from which to choose, applicant chose, with full knowledge of opposer's mark, one which is similar to the mark used by opposer since the beginning of the century.

Applicant offered, as noted above, an explanation for the selection of the design portion of its mark (that is, an animal next to a phonograph player). However, given Mr. Horne's prior knowledge of opposer's mark, and the fame of opposer's mark, suffice it to say we have our doubts that applicant's adoption of its mark can be characterized as purely an arbitrary choice. *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1285 (Fed. Cir. 1984) ["there is...no excuse for even approaching the well-known trademark of a competitor, that to do so raises 'but one inference--that of gaining advantage from the wide reputation established by [the prior user] in the goods bearing its mark'...." Certainly, Mr. Horne's denial (dep., p. 19) that, at the very least, he had in mind opposer's mark when he created applicant's mark, strains credulity.

record, we would reach the same result on the merits of this

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Finally, given the low level of sales and advertising under applicant's mark, the absence of any evidence of actual confusion between the parties' marks is of very limited probative value. In any event, the test is likelihood of confusion, not actual confusion.

Decision: The opposition is sustained and registration to applicant is refused.

R. L. Simms

T. J. Quinn

C. E. Walters
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

case.